

NEG-206US

09/837,193

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**REMARKS**

Claims 1 - 22 are currently pending in the application. Claims 21 and 22 have been amended for review by the Examiner. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each.

Claims 21 and 22 have been objected to for an informality identified by the Examiner. Claims 21 and 22 have been amended per the Examiner's recommendation.

Claims 1 - 3, 8 - 10, 13, 14, 18, 21 and 22 have been rejected under 35 U.S.C. 103(a) as being anticipated by Gacek (6,795,205) and Yeung et al. (6,690,481). This rejection is traversed.

The previous amendment provided in response to the office action dated November 15, 2004 explained that Gacek did not provide certain features of the subject invention. Two of the features discussed were that the printer is the element that provides the printed information notification to the network and that the print information provided by the printer includes the amount of information printed. In the subsequent office action dated May 5, 2005, the Examiner stated in paragraph 2 that the argument was fully persuasive and has withdrawn the prior rejections relative to Gacek. However, the Examiner now sites Gacek in combination with a different reference (Yeung) as a basis for rejection of the claims. The rejection is not well grounded and should be withdrawn.

Gacek is directed to providing a remote print control capability that allows data to be printed on an end user printer that is connected to a network. The key focus of the Gacek configuration is the authorization of the print capability to eliminate or reduce unwanted print data at the end user. Gacek requires that the authorization of the print function exist at a separate computing function (server) from the print capabilities available in the printer. Gacek enables status information to be transmitted to the remote intermediary service from the print server to compensate the end user for the printing supplies (ink and paper) used. As acknowledged by the Examiner, Gacek

does not proved a notification of the amount of data printed but rather only focuses on the number of pages that have been printed. This focus on number of pages does not allow for calculation of specific amounts of data and the resulting specific amounts of ink and paper used. In addition, this feature of notification is provided in Gacek from a server element that is separate from the printer element. This is different from the subject invention which clearly states that the amount of data printed is calculated at the printer. Gacek does not provide the amount of information printed and does not provide the notification of the amount of information directly from the printer as does the subject invention. Therefore, Gacek does not provide the same features of the subject invention as acknowledged by the Examiner in the office action dated May 4, 2005.

Yeung et al. is directed to a remote print control capability that sends print information to a printer. The printer is connected to the remote information source through a television Set Top Box. Notification of print status, as defined by Yeung et al. in the abstract, “..is provided from the Set Top Box back to the cable head end to provide notification of successful printout back to the remote internet site.” Yeung et al. clearly describes the notification of print status as being provided by an element other than the printer, specifically, the Set Top Box. This is different from the subject invention in which the printer provides the notification of the amount of information printed. Secondly, Yeung et al. provides status information at a printed page only level and not the amount of information as does the subject invention. Yeung et al. defines the status information on col. 12, lines 39 - 56 as, “... the notification client at the set top box notifies the cable head end as each sheet of the print job is commenced, as each sheet is concluded, and as the print job is concluded.” This is page level print status only and not an amount of information printed. The subject invention is concerned with the amount of actual information printed and not just the number of pages sent to a print queue as clearly stated in claim 1, “...notifying an **amount** of information...” Therefore, Yeung et al. does not provide the same at least two features

of the subject invention which are not provided by Gacek. Therefore, no combination of Gacek and Yeung would provide or make obvious the two features.

The subject invention provides a capability which allows a printer to control, calculate, and communicate the amount of information the printer has printed. Once this is accomplished, the notification of amount of information can be used to compensate the owner of the printer for the used print supplies. The subject invention has several features that are not provided by either Gacek or Yeung et al. Two of these features are: (1) the printer is the element that provides notification of print information, and (2) notification of print information by the printer includes the amount of information that has been printed.

Each of the independent claims (claims 1, 9, 11, 13, 15, 18, 19, 21 and 22) of the subject invention clearly states that the printer is the element that provides the printed information notification and that the print information provided includes amount of information printed. As discussed above, neither Gacek or Yeung et al. in combination or individually provide either of these features as discussed above, and no combination would make obvious these features.

The Examiner also claims that it would be obvious to combine the printer and the servers in the Set Top Box. This is incorrect. The Set Top Box is a device that has multiple functions the most significant of which is to manage the programming decoding and distribution of television signals to the television set. It would not be obvious to combine with a printer functionality for measurement of the amount of printed information.

Furthermore, the dependent claims (2 - 8, 10, 12, 14, 16 - 17, and 20) include all the features of the base claims. Therefore, these defendant claims are also not provided by any combination of Gacek and/or Yeung et al. either in combination or individually.

Moreover, with respect to claim 3, the feature described in col. 12, lines 61 - 67 of Gacek is that of printing 'new' information and not 'updated' information as in that of the subject invention. The reference cited by the Examiner simply discussed print

information received from a different provider (i.e., a third-party merchant through and intermediary service). This is not the updating of the current print job as is performed by the subject invention. The subject invention compares the information to be printed against the previously printed information to ensure that only updated information is printed. In Gacek, the ‘new’ print request from the third-party merchant could be the same print as that which was previously printed from a different provider. Thus, the feature described by Gacek is not the same updating feature of the subject invention. Furthermore, as a dependent claim, the printer of claim 2 includes all the features of the base claim.

Claims 1, 11, 12, 15 - 17, 19, and 20 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Kolls (6,615,183) and Yeung et al. (6,690,481). This rejection is traversed.

With respect to claims 1, 11, 12, 15 - 17, 19, and 20 all contain directly or by dependency, the features discussed above. That is, the printer has the ability to notify the information providing system of the amount of information printed. These features are not provided by Kolls. The reference cited by the Examiner (block 1502, column 36, lines 55 - 60) does not identify the feature of the subject invention. This reference relates to what type of data can be included as transaction data to be printed. This is not the feature identified in the independent claims 1, 11, 15, 19, 21, and 22. Kolls, as acknowledged by the Examiner, does not provide the feature of notifying the server of the amount of information. The Examiner contends that this would be obvious and suggests that Kolls discloses the feature based on the “..amount of data indicated by the printer.” The Examiner is incorrect; Kolls does not have this feature. Kolls only discusses the amount of time required to processes the information and not the amount of information that is printed. Therefore, as Kolls does not indicate this amount of information nor discusses any notification of information amounts, the suggestion that it would be obvious to include this as a feature can only be derived by hindsight from the subject application.

Furthermore, the Examiner has rejected several of the dependent claims based on the use of the Internet as the connection means. The similar argument discussed above relative to Gacek and Yeung et al. also applies here. That is, the connection to the internet is relative to the printer specified in the independent claims. As a dependent claim, The printer of claims 12 and 16 includes all the features of the base claims. These features are not provided by Kolls, thus the connection of the subject invention printer to the Internet is not provided by Kolls.

Claim 4 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (6,615,183) and Yeung et al. (6,690,481) and further in view of Massarsky (6,718,123).

As for claim 4, this is a dependent claim whose base claim describes a printer that has at least one feature not provided by Kolls as discussed above. As a dependent claim, the printer of claim 4 includes all the features of the base claim. Claim 4 of the subject invention identifies the feature of printing the information in the margin of the print medium. Again, the feature is subject to the limitations of claim 1, that is that the printer be capable of notifying the information service provider that information has been printed. Hence, this feature is not anticipated by Kolls in combination with Massarsky or separately since the feature is not provided by either Kolls or Massarsky.

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (6,615,183) and Yeung et al. (6,690,481) and further in view of Massarsky (6,718,123) and Muramatsu et al. (5,818,606).

As for claim 5, this is a dependent claim whose base claim describes a printer that has at least one feature not provided by Kolls as discussed above. As a dependent claim, the printer of claim 5 includes all the features of the base claim. Claim 5 of the subject invention identifies the feature of printing the information in the margin of the print medium when said print field is reduced. Again, the feature is subject to the limitations of claim 1, that is that the printer be capable of notifying the information service provider that information has been printed. Hence, this feature is not

anticipated by Kolls in any combination with Massarsky or Muramatsu et al. since the feature is not provided by either Kolls, Massarsky or Muramatsu et al.

Claim 6 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (6,615,183) and Yeung et al. (6,690,481) and further in view of Freedman (4,839,829).

As for claim 6, this is a dependent claim whose base claim describes a printer that has at least one feature not provided by Kolls as discussed above. As a dependent claim, the printer of claim 6 includes all the features of the base claim. The arguments for claim 6 are similar to those discussed above for claims 4 and 5. That is, the subject invention identifies the feature of printing the information in the margin of the print medium when said print field is reduced. Again, the feature is subject to the limitations of claim 1, that the printer be capable of notifying the information service provider that information has been printed. Hence, this feature is not anticipated by Kolls in any combination with Freedman, since the feature is not provided by either Kolls or Freedman.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (6,615,183) and Yeung et al. (6,690,481) and further in view of DeBruin-Ashton (6,014,629).

As for claim 7, this is a dependent claim whose base claim describes a printer that has at least one feature not provided by Kolls as discussed above. As a dependent claim, the printer of claim 7 includes all the features of the base claim. The arguments for claim 7 are similar to those discussed above for claims 4, 5 and 6. That is, the subject invention identifies the feature of printing the information in the margin of the print medium when said print field is reduced. Again, the feature is subject to the limitations of claim 1, that the printer be capable of notifying the information service provider that information has been printed. Hence, this feature is not anticipated by Kolls in any combination with Freedman, since the feature is not provided by either Kolls or Freedman.

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In view of the foregoing, it is requested that the application be reconsidered, that claims 1 - 22 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: mike@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson, P.C.).

Respectfully submitted,



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